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| 09/755,305 | 01/02/2001 | Gen Suzuki | F-6806 | 5011 |

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Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

EXAMINER

MARKS, CHRISTINA M

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| ART UNIT | PAPER NUMBER |
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3713

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,305

Applicant(s)

SUZUKI, GEN

Examiner:

C. Marks

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 01.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every
5 feature of the invention specified in the claims. Therefore, the following list of claimed devices
must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

- 1) device for “displaying a route” (see e.g. claims 1 and 11)
- 2) device for “determining a value” (see e.g. claims 1, 2, 3, and 11)
- 3) device for “moving a character set as an object” (see e.g. claims 1 and 11)
- 10 4) device for “controlling a peculiar value” (see e.g. claims 1, 9, and 11)
- 5) device for “controlling appearance of event production squares” (see e.g. claims
1, 9, and 11)
- 6) device for “producing an event” (see e.g. claims 1, 6, 10, and 11)
- 15 7) device for “scrolling a row of numerical values” (see e.g. claim 3)
- 8) device for “selecting the value to be obtained” (see e.g. claim 3)
- 9) device for “letting a game have a story proceed” (see e.g. claim 4)
- 10) device for “selecting an ending” (see e.g. claims 5 and 8)
- 11) device for “providing a practice environment of a game” (see e.g. claim 7)

20 The drawings are objected to because TRAINING is improperly spelled as “tiraining” in
FIGURE 9, step 51.

A proposed drawing correction or corrected drawings are required in reply to the Office
action to avoid abandonment of the application. The objection to the drawings will not be held
25 in abeyance.

Specification

The abstract is objected to because it is of improper length. The abstract should be limited to 150 words or less. Appropriate correction is required.

5

The disclosure is objected to because of the following informalities: out of sight is improperly spelled as "outasite" on page 6, line 3; left is improperly spelled as "let" on page 26, line 10.

Appropriate correction is required.

10

Claim Objections

Claims 1 and 11 and those dependent therefrom are objected to under 37 CFR 1.75(d) because the terms and phrases used in the claims must find clear support or antecedent basis in the descriptions so that the meaning of the terms in the claims may be ascertainable by reference to the descriptions.

15

The phrases "device for controlling a peculiar value," "device for controlling appearance of the event production squares," and "device for letting a game having a story proceed" are not clearly supported in the description.

Applicant is required to state on the record what structure, materials, or acts perform the function recited in claim by distinctly pointing out the structure, materials, or acts by page and line number in the detailed description and by reference number in the figures.

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

5 The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10 Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a game system with a means for a multitude of games to be carried out based upon the result of user actions, does not reasonably provide enablement for: device for “displaying a route,” device for “determining a value,” device for “moving a character set as an object,” device for “controlling a peculiar value,” device for “controlling appearance of event production squares,” device for “producing an event,” device for “scrolling a row of numerical
15 values,” device for “selecting the value to be obtained,” device for “letting a game have a story proceed,” device for “selecting an ending,” device for “providing a practice environment of a game.” The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. One skilled in the art would not be able to, upon reading the description,
20 enable the claimed invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

25 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

 Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as failing to satisfy a means plus function claim limitation as it is not clear based on the disclosure in the application that one skilled in the art would have known what structure, materials, or acts perform the function recited in the limitation. The means plus function limitations: “device for controlling a
30 peculiar value,” “device for controlling appearance of the event production squares,” “device for

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letting a game having a story proceed," and are indefinite because one skilled in the art cannot link particular structures within the written description to claim limitations.

For examination purposes only, the particular means plus function language will be
5 interpreted for its literal meaning as is best understood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
10 obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the
15 manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 20
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
- 25

Claims 1, 4, 5, 9, 10 and 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive.

Regarding claims 1 and 11, Darrow presents a board game, that is a route composed by arranging a plurality of squares displayed on a gaming board (FIG 1) where there is a lottery

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device (FIG 5) for determining a value. Characters (FIG 2 are provided for moving the player along the route according to the value determined by the lottery device (Column 9 (as counted by Examiner), lines 36-39). Darrow also incorporates events related to the squares that are produced when the character lands at a specific stop position. Darrow incorporates either

5 financial benefit or loss relating to a character landing upon on a specific square, such as Community Chest or Chance (Column 2, lines 35-38).

It is well known in the art that board games, such as the one disclosed by Darrow, can be incorporated into a program on a computer readable storage medium for play on a computer or gaming console. In an article about Darrow's board game (created as an electronic version)

10 adapted for Nintendo 64, the author notes how little character tokens have taken on full 3D splendor with color and animation (IGN.com, page 1).

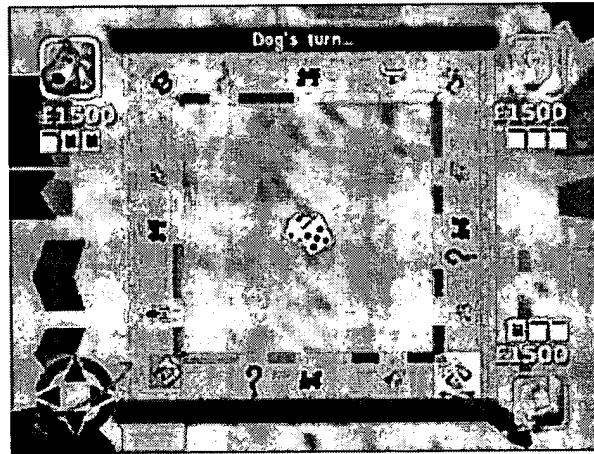
Because of this advantage it would be obvious to one skilled in the art at the time of invention to incorporate the game disclosed by Darrow into an electronic version, to enhance user enjoyment.. Furthermore, one skilled in the art would know that to craft this electronic

15 version specific electronic devices and functionality would be required. Any game that is adapted into a gaming console must have the basic requirements of a game screen, input device, and gaming control. There must be an image display for which the user can view the game, there must be an input device for outputting a signal according to user interaction, and finally the game must have some sort of control, which would coordinate the functionality among the devices

20 required for the game to function properly.

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To construct the functionality of the board game disclosed by Darrow into an electronic version, one skilled in the art would know that a route presentation device must be incorporated for displaying the squares on the screen of the display device.

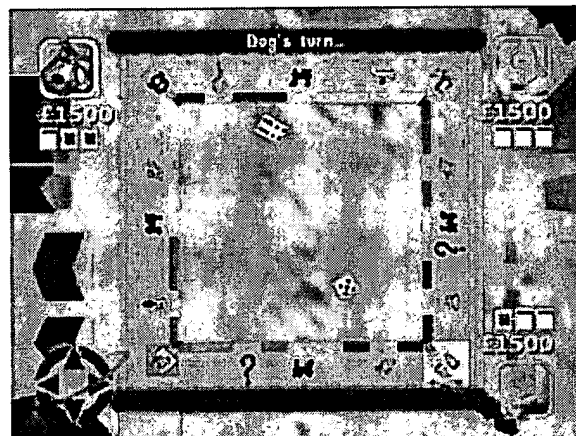


5

Screen Shot from N64 showing a display of a route composed of arranging a plurality of squares as well as symbols.

Furthermore, as die are required in the game as disclosed by Darrow, in an electronic version one skilled in the art would require a lottery device, deployed by user input, for determining a value as a result of player input from the input device as players take turns rolling dices by axiomatically pressing a designated button on the input device.

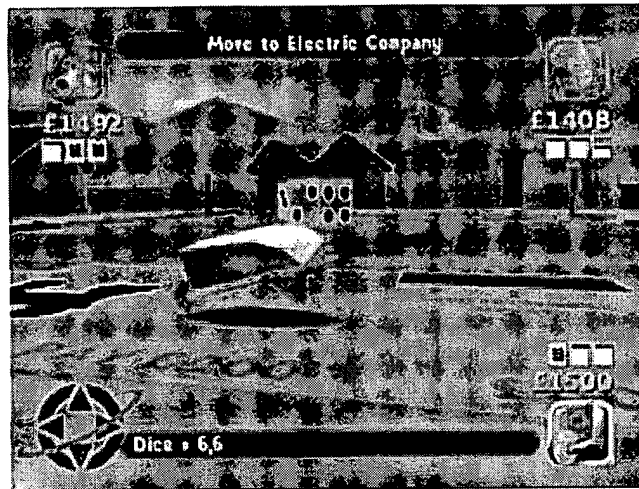
10



Screen shot from N64 showing the lottery devices used for obtaining a value based upon the player rolling the die.

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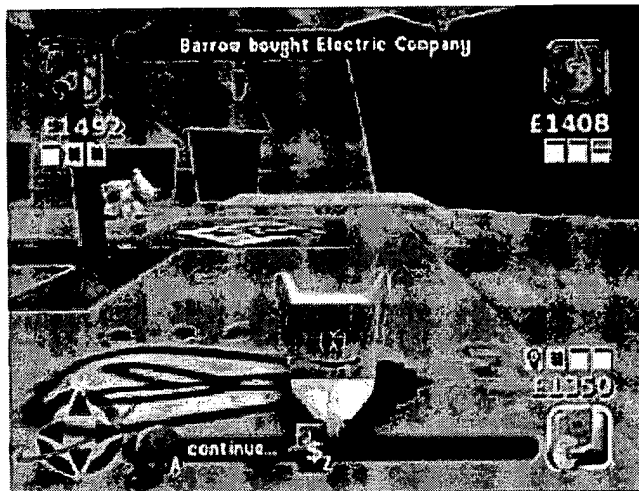
Darrow discloses that his characters move around the gaming board based upon the result of the lottery device. Therefore, in an electronic version incorporating this same concept, one skilled in the art would use a character position control device would be used in order to move a character along the gaming route based upon the value obtained from the lottery device.



Screen shot from N64 showing the character moving to the along the route as a result of the value obtained from the lottery device (shown in background and on bottom of screen).

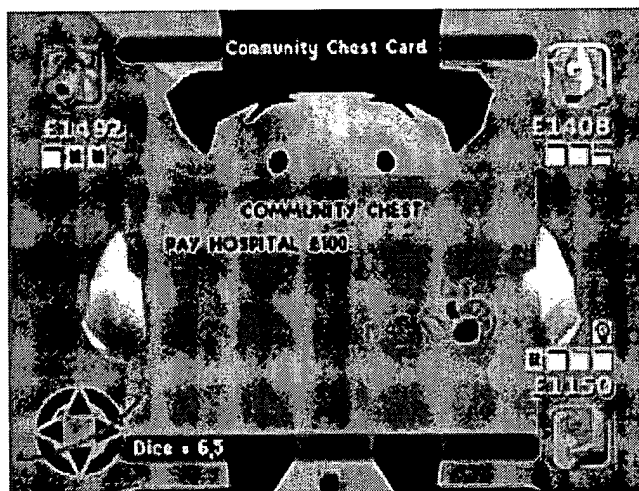
Darrow incorporates events on the squares, therefore a means for controlling a value relating to an event based upon the position of the character would be incorporated into an electronic version by one skilled in the art in order for the game to realize the exact location of a character as knowing the position of each character would be axiomatic to the functionality of the game. Furthermore, because this value provides the game control device with the location of the character, it could be used in order to adjust the appearance of the event production squares in that a control device could be used for allowing a different view of the squares based upon the position of the player, which would be determined by the stored value.

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Screen shot from N64 with the presentation of the square adjusted based upon the position of the character.

- 5 As Darrow discloses that events can occur based upon the character landing on a certain square, such as Community Chest or Chance, the electronic version would also incorporate these events and one skilled in the art would know that an event control device would be used to realize when an event has occurred and when the event has occurred, producing the event.



Screen shot from N64 showing an event relating to an event production square, in this case when the character hit the stop position upon Community Chest

In view of the discussion above, it would have been obvious to one skilled in the art at the time of invention to incorporate the devices and controls in order to adapt the concepts of the board game of Darrow into the user-friendly and convenient atmosphere of an electronic gaming console environment.

5 In regards to claim 4, Darrow discloses characters in his game board and in the electronic version these characters can be animated in video sequences or stories relating to events in the game and the game is always proceeding as the stories occur and change as they are incorporated into the game. Hasbro Interactive discusses such an example. If it is determined that a character hits a certain space where the particular event is to be "sentenced" to another square, an
10 animation is run and a token is catapulted or otherwise sent to jail (page3, lines 31-32) in a short story sequence.

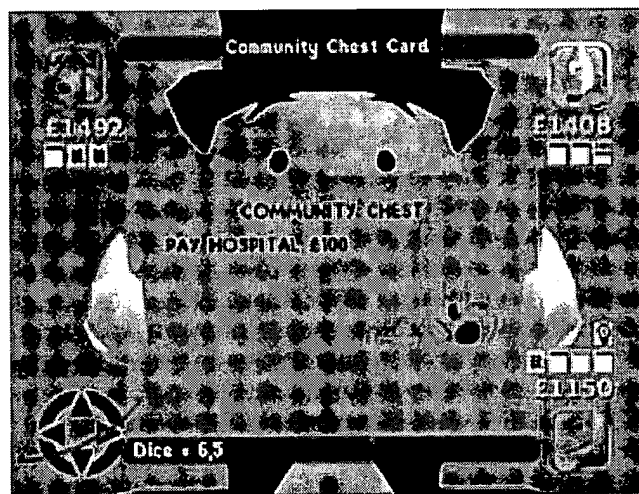
In regards to claim 5, one skilled in the art would know that a gaming system as disclosed above would have an ending control device to realize when the current game has ended and selecting a proper ending from a plurality of endings and presenting an image relating to the
15 ending. The proceeding situation of game play by the characters would determine which of the plural endings is to be presented based upon a win by any one of the players. It would be crucial to player satisfaction to present these ending images in order for the players to see the results of the game in order to be able to assess performance and establish victory.

In regards to claim 9, Darrow incorporates events on the squares, therefore a means for
20 controlling a value relating to an event based upon the position of the character would be incorporated into an electronic version by one skilled in the art in order to realize the exact location of a character as knowing the position of each character would be axiomatic to the

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functionality of the game. This value would be adjusted based upon the position of the character. When the value reaches a certain number and it is determined that the character has stopped on an event, the game control device will be provided with the location of the character, in order to adjust the appearance of the event production squares.

- 5 In regards to claim 10, Darrow discloses that events can occur based upon the character landing on a certain square, such as Community Chest or Chance, the electronic version would also incorporate these events and one skilled in the art would know that an event control device would be used to realize when a character has stopped on a square associated with an event and thus producing the event.



10 Screen shot from N64 showing an event relating to an event production square, in this case when the character hit the stop position upon Community Chest

15

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive in further view Oshima et al. (US Patent No. 5,601,487).

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What Darrow and Hasbro Interactive disclose, teach, and/or suggest has been discussed above and is incorporated within.

Applicant admits that a reason that many of current video games are likely to become dreary is that because each event square is related to each event, even if a player wants to
5 experience the event related to the square, it is impossible unless the square is arranged in the route. Further, Applicant admits that a system that is capable of allowing player's wish to reflect on production of events is desirable (page 2, 9-17).

Oshima et al. also teaches that when users cannot directly influence the results of the game, it can become monotonous and not interesting (Column 1, lines 20-21). To overcome the
10 fault, Oshima et al. disclose an indicator, which controls the progress of the game, that is displayed on the display and its contents are scrolled at a speed based upon the selected character. The indicator can then be stopped in response to an external operation and the progress of the game is controlled based upon the indicator (Column 1, lines 55-63). Further, it would axiomatic to the functionality of the scrolling indicator to have a device to determine the
15 value that was selected by the user.

The problem with lottery devices independent of user control stated above is present in the gaming system disclosed by Darrow in view of Hasbro Interactive. With the teachings from Applicant's admission and Oshima et al., it would have been obvious to one skilled in the art at the time of invention to incorporate a user-driven lottery device, such as the one disclosed by
20 Oshima et al., as opposed to a random lottery device into the game system of Darrow and Hasbro Interactive in order for it to become more appealing to users as they would feel they have been given some control over the game. With this incorporation, users would have better chances of

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landing on the spaces in which the desire to visit and more excitement would be provided as user would feel that the fate of their turn and the result of the game does not rest solely on fate, but on skill.

Claims 6/1, 6/2, 6/3, 6/4, and 6/5 are rejected under 35 U.S.C. 103(a) as being
5 unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive further in view of the Oshima et al., further in view of Baker et al. (US Patent 6,106,399).

What Darrow, Hasbro Interactive, Oshima et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

The event presentation disclosed by Darrow and incorporated into an electronic version
10 by Hasbro Interactive is based upon events that inform a player of change in status of the game. However, as taught by Baker et al., to enhance the capabilities of the game, additions including new play operations, game resources, events related to unfolding of a background story or unconnected events can be incorporated into a computer-based game (Column 16, lines 40-43). These additions disclosed by Baker et al. would axiomatically use user input as a means for
15 interaction between the player and the additions.

Therefore, it would have been obvious to one skilled in the art at the time of invention to incorporate more sophisticated events into the game system disclosed by Hasbro Interactive in order to provide a more interesting increased player interest as the player can compete or interact in a new aspect of the game resulting from landing on an event square, not as a standard
20 occurrence in a normal game.

Claims 7/6/1, 7/6/2, 7/6/3, 7/6/4, and 7/6/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive further in

view of Oshima et al. further in view of Baker et al. (US Patent 6,106,399) further in view of Stamper et al. (US Patent No. 5,267,734).

What Darrow, Hasbro Interactive, Oshima et al., and Baker et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

5 Stamper et al. Disclose that allowing a user to play a sequence before the actual time of gaming is allowed as the player can practice for the upcoming event with the aim to successfully accomplish the requirements of the game sequence when it really counts (Column 2, lines 32-37). In regards to the device discussed above that incorporates the concept of Darrow in an electronic environment with a spinner based upon skill, it would have been obvious to one
10 skilled in the art at the time of invention, based upon the teaching of Stamper et al., to allow players to have a practice time before the actual game. This would allow the players to become more skilled at operating the lottery device and more comfortable with their ability to correctly choose the result desired from the lottery device when the time counts.

15 Claims 8/6/1, 8/6/2, 8/6/3, 8/6/4, and 8/6/5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Darrow (US Patent No. 2,026,082) in view of Hasbro Interactive further in view of Oshima et al. (US Patent No. 5,601,487), further in view of Baker et al. (US Patent No. 6,106,399).

20 What Darrow, Hasbro Interactive, Oshima et al., and Baker et al. disclose, teach, and/or suggest has been discussed above and is incorporated herein.

One skilled in the art would know that a gaming system as disclosed above would have an ending control device to realize when the current game has ended and selecting a proper

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ending from a plurality of endings and presenting an image relating to the ending. It is well known in the art to create a multiplicity of different endings and display specific ones based upon the performance and circumstances of the game in order to keep player interest. The system would need to have endings associated with a win by any one of the players and it would be crucial to player satisfaction to present these ending images in order for the players to see the results of the game in order to be able to assess performance and establish victory. Therefore, the ending presented in the system is directly based upon the experience and result of the game up to that point.

10

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent No. 3,834,711: Gaming system rotating a light bulb beneath the playing area through a plurality of positions allowing selective manual operation by players as they can bring the light bulb to a halt at a random position to provide a chance selection of one of the playing positions (Abstract).

US Patent No. 3,425,699: Teaches that electrical games of chance are known to the art wherein a motor is employed to drive a rotary switch to serially light lamps on a display board where in a player controls the device (Column 1, lines 32-35).

20

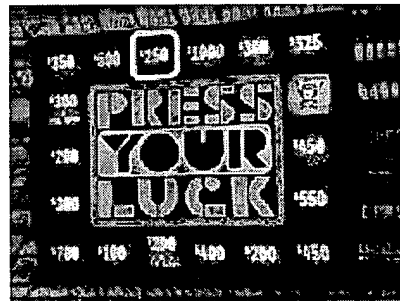
US Patent No. 2,587,381: Amusement apparatus which by simple manipulation of control means will present a signal of the character depending upon how long a period of time

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the control means is engaged by the operator (Column 1, lines 4-8). The symbols of selection are presented in a row of predetermined range (FIG 1).

US Patent No. 6,331,145: Teaches that a player who does not have any physical control over the action of the lottery device is prevented from determining the outcome of the lottery device. Consequently, the computer versions of games are less exciting since the lack an important element of the game, the feel and control over the lottery device. (Column 1, lines 18-23).

Carruthers Company: In their game show, PRESS YOUR LUCK, as described on <http://gscentral.net/pylhista.htm> by Brad Francini, a board was incorporated in which a light would dance around and when the contestant hit the red button presented in front of them, the light would stop at the square and the contestant would receive an event based upon the result of the input from hitting the red button.



Screen shot of game board from Carruthers Company with scrolling light device for scrolling a predetermined range of the numbers where the scrolling of the lights is stopped based upon input by the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Marks whose telephone number is (703)-305-7497. The examiner can normally be reached on Monday - Friday (7:30AM - 4:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, V. Martin-Wallace can be reached on (703)-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9302 for regular communications and (703)-872-9303 for After Final communications.

- 5 Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1148.

C. Marks

C. Marks

10 September 10, 2002

Michael O'Neill

MICHAEL O'NEILL
PRIMARY EXAMINER